



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,278	01/22/2002	Hiroya Kumashio	217967US2	7574
22850	7590	12/12/2007		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER DULANEY, BENJAMIN O	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 12/12/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/051,278

Applicant(s)

KUMASHIO, HIROYA

Examiner

Benjamin O. Dulaney

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 9/18/07 have been fully considered but they are not persuasive.

In response to applicant's argument for claim 2 that Tonkin teaches that user settings left empty or only generally selected are preferable and therefore not "impermissible", examiner disagrees. Firstly, Tonkin does not teach that all generally selected settings are preferable, only that, in the case of document bindings, it is "generally" preferable. Hence this argument would not even extend to all other features that could be generally selected through the teachings of Tonkin as document bindings are only used as an example. Secondly, even if all generally selected settings were "preferable" that would not preclude them from being impermissible to send straight to a printer (as a standard printer would either produce an error or an unknown result if an un-specific setting were submitted). In making the current argument, applicant ignores the purpose of the server in Tonkin as well as in the invention of the claim in dispute. In both Tonkin and the present claim, the server serves as a means to determine impermissibility of settings that were submitted from the client. Simply because settings were preferable in the client does not disqualify them from being impermissible in the server. In other words, common sense would dictate that the most "preferable" settings to a generic user would be a generic setting (for example, a yes or no setting for document binding), so that the user would not have to be educated on how all specific settings work or do not work with each

other. This would not mean that a "yes" for document binding is permissible to send straight to a printer simply because it is preferable in the client.

Regarding applicant's argument that Tonkin does not teach changing settings that were set by a user, Examiner disagrees. Tonkin clearly teaches the concept of a user generally selecting a setting so that the server can determine which specific setting is proper.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 1) Claims 2, 4-9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 6,134,568 by Tonkin.
- 2) Regarding claim 2, Tonkin teaches a printing system (Figure 1) having at least one printer, comprising: a document supervisory client (Figure 1, item 31 or 32) configures to generate print condition settings (Figures 5A-5F; Column 7, line 11 – Column 8, line 53); and a document supervisory server (Figure 1, item 60) configured to control printing based upon a printing request from the document supervisory client in accordance with the print condition settings (Column 13, lines 1-24; Column 13, line 52- Column 14, line 23); wherein said document

supervisory client makes a query to the document supervisory server via a network if the print condition settings are permissible in a printer (Column 9, line 24 – Column 10, line 43), said document supervisory server returns advisability of the print condition settings to the document supervisory client (Column 9, line 24 – Column 10, line 43), wherein said document supervisory server changes a combination of the print condition settings (Column 9, line 24 – Column 10, line 22) and sends a permissible combination including one set of changed print condition settings to the document supervisory client when determining the print condition settings are impermissible (Column 9, line 24 – Column 10, line 43), and wherein said document supervisory client generates a user interface based on the one set of changed print condition settings (Figures 8A-9), and the combination of the print condition settings changed by said document supervisory server is a combination of a print condition settings that were set by a user of the printing system (Column 9, lines 24-37).

3) Regarding claim 4, Tonkin teaches a printing system, comprising: a first computer including a document supervisory client configured to generate print condition settings (Figures 5A-5F; Column 7, line 11 – Column 8, line 53); and a second computer including a document supervisory server configured to perform printing base upon a printing request from the document supervisory client in accordance with the print condition settings (Column 13, lines 1-24; Column 13, line 52- Column 14, line 23); at least one printer connected to a network (Figure 1); wherein said document supervisory client makes a query to the document supervisory server via a network if the print condition settings are permissible in a

printer (Column 9, line 24 – Column 10, line 43), said document supervisory server returns advisability of the print condition settings to the document supervisory client (Column 9, line 24 – Column 10, line 43), wherein said document supervisory server changes a combination of the print condition settings (Column 9, line 24 – Column 10, line 22) and sends a permissible combination including one set of changed print condition settings to the document supervisory client when determining the print condition settings are impermissible (Column 9, line 24 – Column 10, line 43), and wherein said document supervisory client generates a user interface based on the one set of changed print condition settings (Figures 8A-9), and the combination of the print condition settings changed by said document supervisory server is a combination of a print condition settings that were set by a user of the printing system (Column 9, lines 24-37).

4) Regarding claim 5, Tonkin teaches the printing system according to claim 2, wherein said document supervisory server sends initial setting values with applicable character strings and graphs each representing print condition settings to the document supervisory client, and said document supervisory client generates a user interface configured to allow print condition settings based upon the setting values, character strings, and graphs (Column 13, lines 1-24; Column 9, line 24 – Column 10, line 43).

5) Regarding claim 6, Tonkin teaches the printing system according to claim 5, wherein, said document supervisory server changes a combination of the print condition settings and sends a permissible combination including one set of

changed print condition settings to the document supervisory client when determining the print condition settings are an impermissible combination (Column 9, line 24 – Column 10, line 43).

6) Regarding claim 7, Tonkin teaches the printing system according to claim 4, wherein said document supervisory server sends initial setting values with applicable character strings and graphs each representing print condition settings to the document supervisory client, and said document supervisory client generates a user interface configured to allow print condition settings based upon the setting values, character strings, and graphs (Column 13, lines 1-24; Column 9, line 24 – Column 10, line 43).

7) Regarding claim 8, Tonkin teaches the printing system according to claim 7, wherein, said document supervisory server changes a combination of the print condition settings and sends a permissible combination including one set of changed print condition settings to the document supervisory client when determining the print condition settings are an impermissible combination (Column 9, line 24 – Column 10, line 43).

8) Regarding claim 9, Tonkin teaches the printing system according to any one of claims 4 to 8, wherein, said document supervisory client is configured to send an ID which uniquely identifies a document stored in a database in a document supervisory server (Column 6, line 51 – Column 7, line 27; Column 13, lines 26-64), and said document supervisory server obtains an applicable document corresponding to the ID and executes printing the applicable document

in accordance with the print condition settings (Column 13, line 26 – Column 14, line 23).

- 9) Claim 11 is rejected in the same manner as claim 2.
- 10) Claim 12 is rejected in the same manner as claim 5.
- 11) Claim 13 is rejected in the same manner as claim 9.

Conclusion

This is a continuation of applicant's previous finally rejected claims. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin O. Dulaney whose telephone number is (571) 272-2874. The examiner can normally be reached on Monday - Friday (9am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin O. Dulaney

Twyler Lamb
TWYLER LAMB HASKINS
SUPERVISORY PATENT EXAMINER